

REMARKS

Claims 1-2, 5-6 and 9-10 and 13-15 are rejected under 35 USC 103(a) as being anticipated by Smith et al. (USP 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel").

Regarding independent claim 1, the Examiner's interpretation of the description of Smith et al. patent and MS Excel needs further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. ***In re Vaeck***, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding independent claim 1 of the present invention, the Examiner does not show that the references he quoted contain all the claim limitations as required by the third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

First, the Examiner's arguments are somewhat confusing. The Examiner states that Smith et al. teach "A computer-readable medium encoded with a data structure for use in providing a

graphical icon for display on a display of a portable communications device, characterized in that said data structure is encoded as digital data indicative of said graphical icon defined by alternating light and dark stripes, that selected stripes of said light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of said icon and from dark to light and back to dark to indicate a highlight adjacent another edge of said icon, and that altogether said light and dark stripes with shadows and highlights provide said icon with a three-dimensional appearance." Actually the Examiner quotes here the first claim before the AMENDMENT WITH REQUEST FOR CONTINUED EXAMINATION was submitted to the USPTO on November 29, 2004, which is not under consideration here.

Anyway, the Applicant disagrees with the Examiner's statement above and confirms again the considerations presented in the REQUEST FOR CONSIDERATION filed on September 24, 2003, presented in the Reply Brief mailed to the Patent Office on November 10, 2004, and presented in the Appeal Brief filed on May 27, 2004. The main points are briefly summarized below.

The Examiner emphasizes the role of the erasure button 1011 and the draw button 1012 described by Smith et al. and referring to so-called "Smith et al.'s method" for creating an icon. It is self-evident that any bitmap screen will have such means (e.g., erasure button 1011 and draw button 1012 and others) and so-called "Smith et al.'s method" for creating an icon by relying on such means as described by Smith et al. (col. 7, line 50 through col. 8, line 10) has nothing to do with the present invention, i.e., describing a methodology for designing 3-dimensional icons and therefore, Smith et al. does not teach the embodiments of independent claim 1 (in the original form or after amending it)

of the present invention.

Even if, in regard to independent claim 1, for the sake of argument only, we consider that the Examiner's arguments above are correct (which is not true as stated above), the Examiner reference to the "former" claim 1 is irrelevant because the amended claim 1 differs significantly from the claim 1 before the AMENDMENT WITH REQUEST FOR CONTINUED EXAMINATION was introduced.

Moreover, in that regard it is confusing what features of claim 1 (after it is amended and is considered here) are described by Smith et al. The applicant concludes that based on the above considerations the Examiner does not show any relevance of Smith et al. to claim 1 (in amended form) of the present invention.

Furthermore, the Examiner stated that MS Excel teaches (which is not taut by Smith et al. as admitted by the Examiner) "a selected stripe of said light and dark stripes changes from light to dark and remains dark in a region bordering on at least a part of a dark segment of a neighbouring stripe, and beyond said dark segment said selected stripe remains dark or changes back to light to create a shadow adjacent to an edge of said icon". The applicant does not see any connection with MS Excel, as alleged by the Examiner, and the Examiner does not provide any detail or even a hint regarding this connection. It is further confusing that the Examiner continues to use reference to Smith et al. method (see parenthesis after the above quote on the bottom of page 3 of the Official Action of March 9, 2005) which is irrelevant because the reference is made to the MS Excel and not to Smith et al. in the above quote.

Figures 1a, 1b and 2 generated and presented by the Examiner do not prove the point which the Examiner is trying to make and

are irrelevant to the present invention. Of course images presented in Figures 1 and 2A through 2F of the present invention can be somewhat copied (though a "copy" is always not as good as the original) using the bitmap view 1014 shown by Smith et al. in Figure 10 by using said buttons 1011 and 1012 of Smith et al. That is not the issue here. The question is not that the Figures 1 and 2A through 2F of the present invention can be (approximately) reproduced using Smith et al. bitmap of Figure 10. That is obvious because Figures 1 and 2A through 2F are comprised of pixels and therefore naturally any bitmap grid can reproduce these images. The question is whether Smith et al. teaches principles and algorithms for generating images shown in Figures 1 and 2A through 2F of the present invention which is taught by independent claim 1 of the present invention and further taught by other claims. In that regard the Examiner repeated the same arguments which were extensively rebutted in the Appeal Brief filed on May 27, 2004 (see pages 9-12 of the Appeal Brief) and did not present any further reasonable explanations on how Smith et al. teaches the embodiments of claim 1 of the present invention.

Furthermore, the Examiner does not even formerly admit that the part of claim 1 stating that "and a further selected stripe of said light and dark stripes changes from dark to light and remains light in a region bordering on at least a part of a light segment in said neighbouring stripe or in a further neighbouring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight adjacent to said edge or another edge of said icon," is described at all by Smith et al. or by MS Excel.

Summarizing, it is overwhelming that Smith et al. and MS

Excel (separately or in combination) do not describe many claim limitations of claim 1 (as amended by the AMENDMENT WITH REQUEST FOR CONTINUED EXAMINATION submitted to the USPTO on November 29, 2004), as alleged by the Examiner.

Even if, in regard to independent claim 1, for the sake of argument only, we consider that it is possible (which is actually not true since the references quoted by the Examiner do not contain all limitations of claim 1) to combine Smith et al. and MS Excel to make the present invention obvious, the Examiner does not show that the references he quoted contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at the subject matter of claim 1 of the present invention as required by the first criterion of MPEP paragraph 2143 quoted above, or to accomplish that without the benefit of hindsight as required by the case law.

Moreover, Smith et al. and MS Excel do not provide teaching or suggestion for the reasonable expectation of success by combining Smith et al.'s teaching with the MS Excel, as absolutely required by the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

The same arguments (as for claim 1 above) are applied to claims 5 and 9 which are similar in scope to claim 1 of the present invention.

Claim 2, 6, 10 and 13-15 are dependent claims of independent claims 1, 5 or 9, respectively. Since independent claims 1, 5, and 9 are not anticipated by Smith et al. in view of Screen Dumps of Microsoft Excel 2000, as shown above, dependent claims 2, 6 and 9 referred to corresponding novel independent claims 1, 5 and 9 are also novel, and, therefore, they are not anticipated by

Smith et al. in view of Screen Dumps of Microsoft Excel 2000 under 35 USC 103(a).

Withdrawal of the 35 U.S.C. 102(b) rejection of claims 1-2, 5-6 and 9-10 and 13-15 is requested.

Claims 3-4, 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (USP 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel") and further in view of Hess et al. (USP 6,415,320).

The Applicant disagrees with the Examiner's statement above and confirms again the considerations presented in the REQUEST FOR CONSIDERATION filed on September 24, 2003, presented in Reply Brief mailed to the Patent Office on November 10, 2004, and presented in the Appeal Brief filed on May 27, 2004.

Moreover, claims 3-4, 7-8 and 11-12 are dependent claims of independent claims 1, 5 or 9, respectively. Independent claims 1, 5, and 9 are not anticipated by Smith et al. in view of Screen Dumps of Microsoft Excel 2000 and further in view of Hess et al., as shown above. Since each of the dependent claims 3-4, 7-8 and 11-12 narrows the scope of novel and non-obvious independent claims 1, 5, or 9, non-obviousness of claims 1, 5 or 9 will compel non-obviousness of claims 3-4, 7-8 and 11-12. Therefore, claims 3-4, 7-8 and 11-12 are not anticipated by Smith et al. in view of Screen Dumps of Microsoft Excel 2000 and further in view of Hess et al. under 35 USC 103(a).

Withdrawal of the 35 U.S.C. 103(a) rejection of claims 3-4, 7-8 and 11-12 is requested.

The rejections of the Official Action of March 9, 2005, having been obviated or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is solicited.

Respectfully submitted,



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